

ESTTA Tracking number: **ESTTA411547**

Filing date: **05/27/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Ecolab
Granted to Date of previous extension	05/29/2011
Address	370 N. Wabasha Street St. Paul,, MN 55102-2233 UNITED STATES

Attorney information	Scott Johnston Merchant & Gould P.C. P.O. Box 2910 Minneapolis, MN 55402-0910 UNITED STATES sjohnston@merchantgould.com, wschultz@merchantgould.com, aries@merchantgould.com, slindemeier@merchantgould.com, dockmpls@merchantgould.com Phone:612.332.5300
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Applicant Information

Application No	77765022	Publication date	11/30/2010
Opposition Filing Date	05/27/2011	Opposition Period Ends	05/29/2011
Applicant	The Procter & Gamble Company 1 Procter & Gamble Plaza Cincinnati, OH 45202 UNITED STATES		


Goods/Services Affected by Opposition

Class 035. All goods and services in the class are opposed, namely: Business consulting services provided to institutions and businesses in the food service industry
Class 037. All goods and services in the class are opposed, namely: Consultation in the field of food safety related to cleanliness provided to institutions and businesses in the food service industry
Class 041. All goods and services in the class are opposed, namely: Training in the field of food safety compliance
Class 045. All goods and services in the class are opposed, namely: Consultation in the field of food safety related to security and prevention of health risk provided to institutions and businesses in the food service industry; providing regulatory compliance information in the field of food safety in order to assure compliance with food safety laws and regulations

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3467643	Application Date	12/07/2007
Registration Date	07/15/2008	Foreign Priority Date	NONE
Word Mark	FOOD SAFETY SOLUTIONS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1999/03/01 First Use In Commerce: 1999/03/01 Periodical, namely, catalog for food industry featuring food safety products		

Related Proceedings	None
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Attachments	77346390#TMSN.jpeg (1 page)(bytes) 2011 05 27 Notice of Opposition.pdf (8 pages)(283143 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/William Schultz/
Name	William Schultz
Date	05/27/2011

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Ecolab Inc.,)	Opposition No. _____
)	
Opposer,)	Mark: PROCTER & GAMBLE
)	PROFESSIONAL FOOD
v.)	SAFETY SOLUTIONS (and
)	design)
The Procter & Gamble Company)	
)	Application Ser. No. 77-765,022
Applicant.)	
)	Filed: June 22, 2009
)	
)	Published: November 30, 2010
)	

NOTICE OF OPPOSITION

Ecolab Inc., a Delaware corporation having its principal place of business at Ecolab Center, 370 North Wabasha Street, St. Paul, Minnesota 55102 (hereinafter "Opposer"), believes it will be damaged by registration of PROCTER & GAMBLE PROFESSIONAL FOOD SAFETY SOLUTIONS (and design), as a trademark for a variety of services related to the food service industry in International Classes 35, 37, 41 and 45 as set forth in Application Ser. No. 77-765,022, by The Procter & Gamble Company (hereinafter referred to as "Applicant"), and hereby opposes the same upon the following grounds.

1. Ecolab is the owner of the registered trademark FOOD SAFETY SOLUTIONS. At least as early as 1999, and long prior to Applicant's filing date of June 22, 2009, Ecolab adopted and began using the mark FOOD SAFETY SOLUTIONS for use on or in connection with products for the food industry featuring food safety, which are and have been continuously used and marketed in interstate commerce by Ecolab. Ecolab owns common law rights in the FOOD SAFETY SOLUTIONS mark, including in connection with at least the following

products and services: food rotation products, cross-contamination products, temperature control products, personal hygiene products, sanitation and cleaning products, employee safety products, consulting services in the food service area, training in the field of food safety compliance, safety training in the food industry, and consultation in the field of food safety related to security and prevention of health risk.

2. Since at least as early as March 1, 1999, Ecolab adopted and began using the mark FOOD SAFETY SOLUTIONS for use on “periodical, namely, catalog for food industry featuring food safety products,” which is and has been marketed in commerce throughout the United States. On July 15, 2008, the United States Patent & Trademark Office registered on the Principal Register and issued to Ecolab Registration No. 3,467,643 for the mark FOOD SAFETY SOLUTIONS. Registration No. 3,467,643 is presently valid and subsisting and is owned by Ecolab and is prima facie evidence of Ecolab’s exclusive right to use the FOOD SAFETY SOLUTIONS mark in commerce to market “periodical, namely, catalog for food industry featuring food safety products.”

3. Ecolab has expended substantial amounts of money in marketing, advertising and promoting the FOOD SAFETY SOLUTIONS mark on or in connection with numerous goods and services for a variety of industries, including the food services industry, in the United States.

4. Ecolab has enjoyed substantial sales of goods and services in the United States in connection with the use of the FOOD SAFETY SOLUTIONS mark.

5. By reason of the extensive marketing, advertising and promotion of goods and services in connection with the FOOD SAFETY SOLUTIONS mark and the high quality of those goods and services, these marks have extremely valuable goodwill that inures to the benefit of Ecolab.

6. Applicant is an Ohio corporation with a mailing address at 1 Procter & Gamble Plaza, Cincinnati, Ohio, 45202.

7. Applicant is seeking to obtain registration on the Principal Register of the mark PROCTER & GAMBLE PROFESSIONAL FOOD SAFETY SOLUTIONS (and design), Application Serial No. 77-765,022, for use on or in connection with:

- a. Business consulting services provided to institutions and businesses in the food service industry;
- b. Consultation in the field of food safety related to cleanliness provided to institutions and businesses in the food service industry;
- c. Training in the field of food safety compliance; and
- d. Consultation in the field of food safety related to security and prevention of health risk provided to institutions and businesses in the food service industry; providing regulatory compliance information in the field of food safety in order to assure compliance with food safety laws and regulations.

8. There is no issue of priority concerning Application Ser. No. 77-765,022 because Ecolab has use and registrations of its FOOD SAFETY SOLUTIONS mark prior to June 22, 2009, Applicant's filing date of its intent-to-use application.

9. The FOOD SAFETY SOLUTIONS trademark was well known, highly distinctive and recognized by the public as identifying the goods and services of Ecolab prior to June 22, 2009.

10. Ecolab enjoys substantial and exclusive goodwill and good reputation in connection with its FOOD SAFETY SOLUTIONS trademark. This goodwill and reputation will

be harmed by the use and registration of the mark PROCTER & GAMBLE PROFESSIONAL FOOD SAFETY SOLUTIONS (and design) sought to be registered by Applicant.

11. Applicant's intended adoption and use of its PROCTER & GAMBLE PROFESSIONAL FOOD SAFETY SOLUTIONS (and design) mark has been with at least the constructive if not actual knowledge of Ecolab's prior use of its FOOD SAFETY SOLUTIONS trademark on its goods and services.

12. Applicant's intended adoption and use of the PROCTER & GAMBLE PROFESSIONAL FOOD SAFETY SOLUTIONS (and design) trademark has been without Ecolab's consent or permission.

13. The PROCTER & GAMBLE PROFESSIONAL FOOD SAFETY SOLUTIONS (and design) trademark for which Applicant seeks registration is similar in appearance, sound, and connotation to the FOOD SAFETY SOLUTIONS mark. Applicant's PROCTER & GAMBLE PROFESSIONAL FOOD SAFETY SOLUTIONS (and design) mark has the same commercial impression as Ecolab's FOOD SAFETY SOLUTIONS mark.

14. Applicant's PROCTER & GAMBLE PROFESSIONAL FOOD SAFETY SOLUTIONS (and design) mark so resembles Ecolab's FOOD SAFETY SOLUTIONS trademark as to be likely, when applied to Applicant's goods, to cause confusion, mistake, or deception as to the source of origin of Applicant's services by creating the erroneous impression that Applicant's goods originate with, are sponsored by, approved or endorsed by, licensed by, affiliated or associated with, or in some other way legitimately connected to Ecolab.

15. The services for which Applicant seeks registration of the PROCTER & GAMBLE PROFESSIONAL FOOD SAFETY SOLUTIONS (and design) service mark are similar to and are used in connection with the goods and services marketed under Ecolab's

FOOD SAFETY SOLUTIONS mark. For example, both parties provide services under their respective marks in relation to business consulting and safety training in the areas of food safety compliance.

16. The services for which the Applicant seeks registration of the PROCTER & GAMBLE PROFESSIONAL FOOD SAFETY SOLUTIONS (and design) service mark are likely to be sold to or used by the same customers to whom Ecolab sells its goods and services under the FOOD SAFETY SOLUTIONS mark. The goods and services of Ecolab and Applicant will travel in the same channels of trade.

17. Applicant's PROCTER & GAMBLE PROFESSIONAL FOOD SAFETY SOLUTIONS (and design) mark is confusingly similar to Ecolab's FOOD SAFETY SOLUTIONS mark and use thereof by the Applicant on the services specified in Application No. 77-765,022 is likely to cause confusion, mistake, or deception that Applicant's goods and services are those of Ecolab or are otherwise endorsed, sponsored, or approved by Ecolab, whereby Ecolab will be damaged by registration of Applicant's PROCTER & GAMBLE PROFESSIONAL FOOD SAFETY SOLUTIONS mark on the Principal Register of the United States Patent and Trademark Office.

18. Granting a federal trademark registration to Applicant for its claimed PROCTER & GAMBLE PROFESSIONAL FOOD SAFETY SOLUTIONS (and design) mark as shown in Application Serial No. 77-765,022 would be contrary to 15 U.S.C. § 1052 (d) and would violate or diminish the prior and superior rights of Ecolab in its FOOD SAFETY SOLUTIONS trademark, causing irreparable damage and injury to Ecolab.

PRAYER FOR RELIEF

WHEREFORE, Ecolab asks that its opposition to Application No. 77-765,022 be sustained and that the registration of the term PROCTER & GAMBLE PROFESSIONAL FOOD SAFETY SOLUTIONS (and design) set forth therein be refused. Please direct all correspondence to the attention of William Schultz:

Merchant & Gould P.C.
PO Box 2910
Minneapolis, MN 55402
612-332-5300

Ecolab hereby appoints Scott W. Johnston, Reg. No. 39,721; William D. Schultz; Heather J. Kliebenstein; D. Randall King; John A. Clifford, Reg. No. 30,247; Brent E. Routman; Gregory C. Golla and other attorneys of the firm of Merchant & Gould P.C. as attorneys with the full power to represent Ecolab, to receive all correspondence related thereto and to represent it in all proceedings affecting the potential opposition of the mark.

Accompanying the duplicate signed copies of this Notice of Opposition is the required fee of \$1,200.00. Please charge any fees or credit any overpayment to Deposit Account No. 13-2725 of Ecolab's counsel noted above.

Dated: May 27, 2011

Respectfully submitted,

ECOLAB, INC.

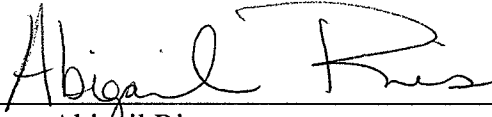
By its attorneys,



Scott Johnston
William Schultz
Merchant & Gould P.C.
PO Box 2910
Minneapolis, MN 55402
(612) 332-5300

CERTIFICATE OF MAILING

I hereby certify that a true and correct copy of the foregoing NOTICE OF OPPOSITION was filed electronically with the Electronic System for Trademark Trials and Appeals this 27th day of May, 2011.



Abigail Ries

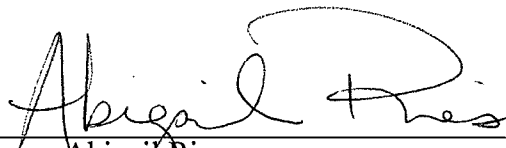
CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing NOTICE OF OPPOSITION has been served by First Class Mail this 27th day of May, 2011 upon the following:

Alison Tan
The Procter & Gamble Company
299 E. Sixth Street
S5-217
Cincinnati, OH 45202

The Procter & Gamble Company
1 Procter & Gamble Plaza
Cincinnati, OH 45202

Patricia B. Hogan
Keating Muething & Klekamp PLL
One East Fourth Street
Suite 1400
Cincinnati, OH 45202



Abigail Ries